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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,744	07/15/2003	Erica Lin	6233.350	6922

7590

07/31/2006

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EXAMINER

SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
1626	

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



### **DETAILED ACTION**

This is a response to applicant's amendment filed on 05/22/06.

#### **Status of the Claims**

Claims 1 and 4-18 have been cancelled.

Claims 2-3 and 19-20 are pending.

Claim 2 has been amended to show the exact substitutions.

Claim 19 is allowed.

#### ***Claim Rejections - 35 USC § 102***

The rejection of claim 2 under 35 U.S.C. 102(b) has been withdrawn.

#### **Claim Rejections - 35 U.S.C. § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over JP5-222256 ('256') for the reasons set forth in the previous office action mailed on 02/22/06.

### ***Response to Amendment***

Applicant's arguments filed 05/22/06 have been fully considered but they are not deemed persuasive. Applicants argue that substituent X in the prior art (Japanese Patent number 5-222256) does not teach multiple carbon atoms or an alkyl substituent. The Examiner agrees, however, said requirement does not give rise to patentable claims and hence, does not remove the applied reference from a rejection under 35 U.S.C. 103 because the instant claims are homologs of the reference claims. See *in re Druey* cited in the previous office action. Applicants next argue that the reference does not suggest the present substitution, i.e., to move its phosphonate and hydroxyl groups from ortho-positions to para-positions relative to its methylene X group. The claimed compounds would have been obvious to one of ordinary skill in the art because compounds embraced by the reference's genus are positional isomers or homologs of the compounds taught in the reference. In order to establish patentability in positional isomers, there must at least be a comparative showing establishing distinguishing characteristics allegedly showing that the claimed compounds are unobvious. Ex Parte Henkel, 130 USPQ 474 (1960). The instantly claimed compounds would therefore have been suggested to one of ordinary skill. Additionally, the motivation to make the claimed compounds derives from the expectation that structurally similar compounds

are generally expected to have similar properties and similar utilities. *In re Gyurik*, 596, F2d. 1012, 201 USPQ 552 (CCPA), 1979.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the term “comprising” in compound claims is inappropriate because the term is inclusive and fails to exclude unrecited elements. Comprising leaves the claim open for inclusion of unspecified elements. *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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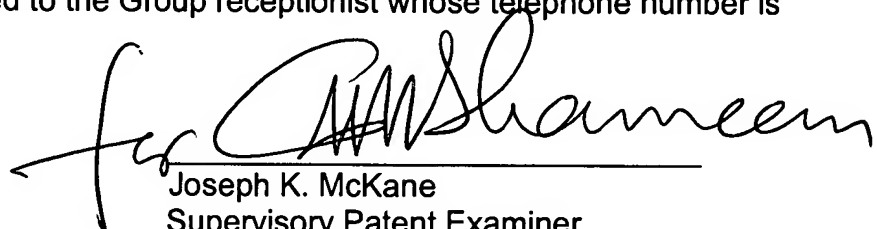
Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS  
July 25, 2006

  
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Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1600  
Technology Center 1